

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 10/759,129  
Attorney Docket No. Q79438

### **REMARKS**

Claims 1-20 are pending in the application. Claims 8-14 have been withdrawn from further consideration by virtue of the Response to Restriction Requirement dated May 4, 2005. Thus, claims 1-7 have been examined.

Claims 1 and 3 are amended. No new matter is presented.

Dealing with preliminary matters first, Applicant notes that the Examiner has not indicated acceptance of the drawings submitted January 20, 2004. Accordingly, the Examiner is kindly requested to indicate acceptance of the drawings in the next action.

In the Office Action, Claims 1-2 and 4-7 have been rejected on obviousness-type double patenting grounds, claims 1-7 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite, and claims 1-2 and 7 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Gottwald (U.S. Patent No. 5,858,090). Further, the Examiner indicates that claim 3 would be allowable if rewritten to overcome the 35 U.S.C. § 112, second paragraph rejections, and to include the limitations of the base claim and any intervening claims. The outstanding rejections are addressed below.

#### **Obviousness-type Double Patenting Rejections**

Claims 1-2 and 4-7 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 2-3, 6, 9, and 19-21 of copending Application No. 10/437,973, and claims 1-2 and 7 stand provisionally rejected

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 10/759,129  
Attorney Docket No. Q79438

under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 20-21 of copending Application No. 10/219,812.

As this is a provisional rejection, based only upon pending patent Applications, Applicant elects to defer addressing the merits of the provisional rejection until one of the cited pending Applications issues. Such deferral of addressing the merits of the rejection is clearly contemplated by MPEP § 804(I)(B), which states that a “provisional” double patenting rejection is designed simply to make Applicant aware of a potential problem. No response on the merits is required, as no patented claims are available to be analyzed. Should the Examiner believe that Applicants are required to address the merits of the rejection at this time, she is respectfully requested to identify authority imposing such a requirement.

Applicant reserves the right to address the merits of the provisional double patenting rejection or submit a terminal disclaimer to obviate the rejection.

**Claim Rejections - 35 U.S.C. § 112, second paragraph**

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. This ground of rejection is traversed.

The Examiner contends that the recitation of claim 1 that  $W_2$  is a coating amount after the strip-shaped body has passed the secondary bar is confusing because it is allegedly unclear whether  $W_2$  refers to the amount of excess coating left on the secondary roller as the strip-shaped body has passed or the amount which is available for application to the web. Applicant notes that claim 1 is amended to recite that  $W_1$  is a coating amount of the coating liquid “that is

deposited on the strip shaped body” at the primary bar and  $W_2$  is a coating amount of the coating liquid “that is deposited on the strip-shaped body” after the strip-shaped body has passed the secondary bar”, which is believed to clarify the recited coating amount.

In addition, the Examiner alleges that the recitation of the coating amount at the primary bar is confusing because it is unclear what is supplying coating to the region at the primary bar. Applicant notes that claim 1 is amended to recite the primary bar “is supplied with the coating liquid by a coating liquid supply flow path”, which is believed to clarify what supplies the coating to the primary bar.

Further, the Examiner alleges that claim 3 is indefinite because it is unclear what the term “carrying speed” refers to. Applicant notes that claim 3 is amended to recite the carrying speed “of the strip-shaped body”, which is believed to be sufficiently definite.

Therefore, in view of the foregoing, the rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph is believed to be moot. Accordingly, reconsideration and withdrawal of this ground of rejection is requested.

#### **Claim Rejections - 35 U.S.C. § 102**

Claims 1-2 and 7 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Gottwald (U.S. Patent No. 5,858,090). This ground of rejection is traversed.

Claim 1 defines a coating apparatus for coating with coating liquid a surface of a strip-shaped body carried in a fixed direction, comprising, *inter alia*, a primary bar extending along a width direction of a carrying plane, which is a carrying path of the strip-shaped body; a

secondary bar extending in parallel with the primary bar and disposed at a downstream side of the primary bar; and a between-bars liquid reservoir disposed between the primary bar and the secondary bar for storing the coating liquid at a time of coating of the coating liquid. Claim 1 further recites coating conditions at the primary bar, which is supplied with the coating liquid by a coating liquid supply flow path, and the secondary bar are set so that the following condition is met,  $W_2 < W_1$ , where  $W_1$  is a coating amount of the coating liquid that is deposited on the strip-shaped body at the primary bar and  $W_2$  is a coating amount of the coating liquid that is deposited on the strip-shaped body after the strip-shaped body has passed the secondary bar.

Notwithstanding the Examiner's rejection, Applicant submits that Gottwald fails to teach or suggest all the limitations of claim 1.

For instance, Gottwald teaches that a rotating roll is used to either take up a medium to subsequently transfer the medium to the web or to guide the web over the roll as the medium is applied directly to the web. *See* Gottwald at col. 1, lines 11-18 and col. 6, lines 61-65. Thus, Gottwald teaches a transfer system. Further, Gottwald teaches applying a liquid or pasty medium on a web in such a manner that the collection and buildup of fibers, foreign bodies or similar particles in front of a cleaning doctor blade is prevented, which are problems that are caused by the use of the transfer system. *See, e.g.*, Gottwald at col. 2, lines 31-62.

Without identifying the elements in Gottwald that allegedly correspond to the recited primary bar, secondary bar, and between-bars liquid reservoir, the Examiner alleges that these elements are anticipated by Gottwald. However, Applicant submits that the transfer system of Gottwald with a "rotating roll" cannot properly correspond to the elements of claim 1 as

recited. In this regard, Applicant notes that claim 1 defines a “coating apparatus for coating with coating liquid a surface of the strip-shaped body”, and “ $W_2$ ” is defined as a coating amount of the coating liquid by an amount “after the strip-shaped body has passed the secondary bar”.

Gottwald does not suggest a secondary bar, as defined by claim 1, nor does the transfer system of Gottwald suggest a coating apparatus in which a coating amount at the secondary bar is less than the coating amount at the secondary bar that is deposited on the strip shaped body after the strip shaped body has passed the secondary bar.

Therefore, Gottwald fails to teach or suggest all the limitations of the coating apparatus defined by claim 1. Accordingly, reconsideration and withdrawal of the rejection is requested. Further, claims 2-7 are believed to be allowable at least by virtue of depending from claim 1.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 10/759,129  
Attorney Docket No. Q79438

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Brian K. Shelton  
Registration No. 50,245

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: December 19, 2005